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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,706	07/13/2001	Masamichi Ito	35.C12551 DI	1058
5514	7590	09/22/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			NEURAUTER, GEORGE C	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,706

Applicant(s)

ITO ET AL.

Examiner

George C. Neurauter, Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-12, 17 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-12, 17, and 30-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02082005.09062006.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Art Unit: 2143

DETAILED ACTION

Claims 1-5, 8-12, 17, and 30-37 are pending and have been examined.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 8 February 2005 and 6 September 2006 was filed after the mailing date of the non-final rejection on 1 October 2002. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 2143

Claim Objections

Claim 5 is objected to because of the following informalities:

Claim 5 recites "a designation step of designating data to be transmitted from said second node to said first node and a search step of searching for said data designated at said designated step and of transmitting said designated data from said first node to said second node." In view of claim 1, these limitations should read "a designation step of designating data to be transmitted from said first node to said second node and a search step of searching for said data designated at said designated step and of transmitting said designated data from said first node to said second node."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United

Art Unit: 2143

States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 5, 8-10, 12, 17, 30-31, and 34-35 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6 442 349 B1 to Saegusa et al.

Regarding claim 1, Saegusa discloses a data communication method, for nodes connected via a communication control bus along which transmission of a mixture of control signals and data is enabled, comprising the steps of:

inhibiting entry of predetermined instructions at an instruction entry unit of a first node during a data transfer from said first node to a second node (column 1, lines 17-21 and 52-58; column 2, lines 7-20; column 12, lines 18-40); and

providing a predetermined message for a user, on a display unit at said first node. (column 1, line 49; column 12, lines 18-40)

Regarding claims 2, Saegusa discloses a data communication method according to claim 1, further comprising a step of displaying an alarm message on said display unit at said first node upon entry of one of said predetermined instructions at said instruction entry unit during said data transfer. (column 1, lines 49 and 52-56)

Art Unit: 2143

Regarding claim 5, Saegusa discloses a data communication method according to claim 1, further comprising a designation step of designating data to be transmitted from said second node to said first node and a search step of searching for said data designated at said designated step and of transmitting said designated data from said first node to said second node.
(column 1, line 62-column 2, line 20)

Regarding claim 8, Saegusa discloses a data communication apparatus, which is connected to a network via a communication control bus along which transmission of a mixture of control signals and data is enabled, comprising:

instruction entry means manipulated by a user when entering an instruction; (column 1, lines 52-58)

reception means for receiving a command from a first node via said communication control bus; transmission means for transmitting, to said first node, data corresponding to a command received by said reception means; (column 3, lines 44-46; column 12, lines 18-40; column 18, lines 14-40)

control means for inhibiting, during transmission of data by said transmission means, entry of predetermined instructions at said instruction entry means, and for displaying a predetermined message for said user. (column 1, lines 17-21, 49, and 52-58; column 2, lines 7-20; column 12, lines 18-40)

Art Unit: 2143

Claim 9 is rejected since claim 9 recites substantially the same limitations as recited in claim 2.

Regarding claim 10, Saegusa discloses a data communication apparatus according to claim 8, wherein, upon receipt of a data output end signal from said first node, said control means remove inhibitions on entry of said predetermined instructions. (column 1, lines 52-58; column 17, lines 62-67)

Regarding claim 12, Saegusa discloses a data communication apparatus according to claim 8, which concerns an image data supply source, wherein said command received by said reception means includes information for specifying said image data (column 1, line 62-column 2, line 20).

Claim 17 is rejected since claim 17 recites substantially the same limitations as recited in claim 1.

Claims 30 and 34 are rejected since claims 30 and 34 recite substantially the same limitations as recited in claims 1 and 8 in combination.

Claims 31 and 35 are rejected since claims 31 and 35 recite substantially the same limitations as recited in claim 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2143

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2143

Claims 3, 32, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saegusa in view of US Patent 4 827 347 to Bell.

Regarding claim 3, Saegusa discloses a data communication method according to claim 1.

Saegusa does not expressly disclose wherein said first node is an image data supply source and said second node is a printer for receiving and printing image data, however, Bell does disclose these limitations (column 3, lines 35-41)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Bell discloses that transferring image data from an image data supply source to a printer allows for hard prints to be printed of the image data (column 3, lines 39-41). In view of these specific advantages and that the references are directed to transferring image data between nodes on a bus and the use of an instruction entry unit by a user of a node, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Art Unit: 2143

Claims 32 and 36 are also rejected since these claims recite substantially the same limitations as recited in claim 3.

Claims 4, 11, 33, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saegusa in view of "IEEE 1394: A Ubiquitous Bus" ("IEEE 1394").

Regarding claim 4, Saegusa discloses a data communication method according to claim 1.

Saegusa does not expressly disclose wherein said communication bus includes an IEEE 1394 serial bus, however, "IEEE 1394" does disclose such a communication bus in the context of image transferring (page 1, specifically "Its scalable architecture and flexible peer-to-peer topology make 1394 ideal for connecting devices from computers and hard drives, to digital audio and video hardware"; page 2, specifically "Broad markets for 1394 digital data transport include:...audio, image, and video products for multimedia, printer and scanner products for imaging...")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since "IEEE 1394" discloses that using the IEEE 1394 bus allows for a universal I/O connection and a scalable architecture between devices such as printers and imaging devices (see page 1). In view of these specific

Art Unit: 2143

advantages and that the references are directed transferring image data between nodes over a communication bus, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Claims 33 and 37 are also rejected since these claims recite substantially the same limitations as recited in claim 4.

Regarding claim 11, Saegusa discloses a data communication apparatus according to claim 8.

Saegusa does not expressly disclose wherein said first node is a printer and said communication control bus is an IEEE 1394 serial bus, however, "IEEE 1394" does disclose such a serial bus in the context of image transferring between printers and imaging devices (page 1, specifically "Its scalable architecture and flexible peer-to-peer topology make 1394 ideal for connecting devices from computers and hard drives, to digital audio and video hardware"; page 2, specifically "Broad markets for 1394 digital data transport include:...audio, image, and video products for multimedia, printer and scanner products for imaging...")

Art Unit: 2143

Claim 11 is rejected since the motivations regarding the obviousness of claim 4 also apply to claim 11.

Conclusion

It is noted that the column, line, and/or page number citations used in the prior art references as applied by the Examiner to the claimed invention are for the convenience of the Applicant to represent the relevant teachings of the prior art. The prior art references may contain further teachings and/or suggestions that may further distinguish the citations applied to the claims, therefore, the Applicant should consider the entirety of these prior art references during the process of responding to this Office Action. It is further noted that any alternative and nonpreferred embodiments as taught and/or suggested within the prior art references also constitute prior art and the prior art references may be relied upon for all the teachings would have reasonably suggested to one of ordinary skill in the art. See MPEP 2123.

The prior art listed in the PTO-892 form included with this Office Action disclose methods, systems, and apparatus similar to those claimed and recited in the specification. The Examiner has cited these references to evidence the level and/or knowledge of one of ordinary skill in the art at the time the invention was made, to provide support for universal facts and

Art Unit: 2143

the technical reasoning for the rejections made in this Office Action including the Examiner's broadest reasonable interpretation of the claims as required by MPEP 2111 and to evidence the plain meaning of any terms not defined in the specification that are interpreted by the Examiner in accordance with MPEP 2111.01. The Applicant should consider these cited references when preparing a response to this Office Action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

gcn


JEFFREY PWU
PRIMARY EXAMINER